

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Karla E. Williams
Serial No.: 10/766,604
Filed: January 27, 2004
For: FIBROUS ARTICLES HAVING ODOR ADSORPTION
ABILITY AND METHOD OF MAKING SAME
Art Unit: 3764
Examiner: Catherine L. Anderson
Confirmation No.: 3398
Customer No.: 67,519

Attorney Docket No.: 460.1844USV1

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

In response to the Final Office Action mailed July 7, 2010, and the Advisory Action mailed on October 20, 2010, Applicants respectfully request review of the rejections in the above-referenced application.

No amendments are being filed with this request.

Related Appeals

This request is being filed with a Notice of Appeal. There are no other related appeals.

Status of Claims

Claims 23-25, 27-33, 39, 40, 42, and 43 are pending in the present application, and are all rejected. Claims 23 and 27 are independent. Claims 1-22, 26, 34-38, and 41 were previously canceled.

Clear Errors for Review

Rejection of Claims under 35 U.S.C. §103(a) over Guarracino et al.

Claims 23, 40, and 43 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,944,704 to Guarracino et al. This rejection was first made on pp. 2-3 of a Non-Final Office Action dated January 6, 2010, and was reasserted in the Final Action of July 7, 2010. The claims have not been amended since the rejection over Guarracino was first made. A listing of the claims as they currently stand can be found in the Response After Final dated October 7, 2010.

The Final Action cited three additional United States Patents, Nos. 5,019,062, 5,733,272, and 5,769,833, as evidence to support the §103(a) rejection. The Advisory Action clarified that these three patents are not relied on under the §103(a) rejection.

Summaries of Applicant's arguments against this rejection can be found on pp. 5-6 of the Response dated April 6, 2010, and pp. 5-6 of the Response After Final dated October 7, 2010. Briefly, claim 23 states that zeolite granules are the sole odor-absorbing materials incorporated into the tampon in the claimed method. Guarracino, by contrast, requires an odor control material that is either a buffer (col. 2, l. 22-26) or a

borate salt in conjunction with an acid (col. 2, l. 35-40). The zeolites of Guarracino are merely optional. Thus, Guarracino fails to disclose or suggest a method of incorporating zeolite into a tampon, where zeolites are the sole odor-absorbing material.

Section §2144.04(II) of the MPEP was first cited in the Non-Final Office Action of January 6, 2010 to support the finding of obviousness, but this MPEP section actually supports the patentability of the present claims. MPEP §2144.04(II)(A) does not apply, since the “Omission of an Element and Its Function Is Obvious” only if the function of the element is not desired. In the present application, the method of claim 23 performs the function of the borate salts and acids of Guarracino, namely to suppress or remove odors, so this function is desired.

Furthermore, MPEP section §2144.04(II)(B) states that “Omission of an Element with Retention of the Element’s Function Is an Indicia of Unobviousness” (emphasis added). In claim 23, the borate salts and acids of Guarracino are omitted, and the function of odor suppression and removal, with only the zeolite, is retained. Thus, the MPEP actually holds that claim 23 is patentable over Guarracino because of the omission of the borate salts and acids.

In addition, although the Advisory Action states that the ‘062, ‘272, and ‘833 Patents are merely relied on for evidentiary support, Applicant respectfully reiterates for the record that MPEP §2143.01(V) holds that the proposed modification of a primary reference with secondary references cannot render the primary reference unsatisfactory for its intended purpose. To combine Guarracino with any of the ‘062, ‘272, and ‘833 Patents would render the former unsatisfactory for its intended purpose. The Office Action introduces the ‘062, ‘272, and ‘833 Patents to show that zeolites can be used alone, but to remove the buffers of Guarracino would completely destroy the odor-absorbing capabilities of the articles disclosed therein, as the buffers are essential components in the absorbent articles of Guarracino. This is expressly disallowed by the MPEP.

Rejection of Claims under 35 U.S.C. §103(a) over Guarracino, Kramer, and Marcus

Claims 27-29 and 42 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Guarracino in view of U.S. Patent No. 5,165,152 to Kramer et al, and further in view of U.S. Patent No. 4,826,497 to Marcus et al.

Independent claim 27 recites that, *inter alia*, zeolite granules are the sole odor-absorbing materials incorporated into the tampon. As discussed above, Guarracino fails to disclose or suggest zeolite granules that are the sole odor-absorbing materials incorporated into a tampon, as required by claim 27. The citation of the '062, '272, and '833 Patents fails to cure this deficiency, as do Kramer and Marcus.

Rejection of Dependent Claims under 35 U.S.C. §103(a) over Guarracino, and Kramer and/or Marcus, and/or Hoyes

Claims 24 and 25 have rejected under 35 U.S.C. §103(a) as being unpatentable over Guarracino in view of U.S. Patent No. 5,165,152 to Kramer et al. Claims 30-33 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Guarracino in view of Kramer and Marcus, and further in view United States Patent No. 6,030,608, to Hoyes et al., hereinafter "Hoyes." Claim 39 has been rejected under 35 U.S.C. §103(a) as being unpatenable over Guarracino in view of Marcus.

Kramer, Marcus, and Hoyes all fail to cure the above-described deficiency of Guarracino to disclose or suggest the methods of claims 23 and 27, and are not relied on by any of the Office Actions to do so. Accordingly, claims 24, 25, 30-33, and 39 are patentable over the references of record, for at least the reasons provided above with respect to claims 23 and 27.

Accordingly, it is respectfully submitted that claims 23-25, 27-33, 39, 40, 42, and 43 are patentable. Applicant requests the panel to reconsider and withdraw the rejections to the claims of the present application, and to pass the present application to allowance.

Respectfully submitted,



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